REMARKS

In the Final Office Action mailed March 16, 2011, the Examiner (1) rejected claims 1, 4-13, 16-25, 28-37, and 40-48 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,422,821 ("*Allen*") in view of a webpage for "NCOA Description" from www.Anchorcomputer.com (Reference U of the PTO-892) ("*Anchor*"); and (2) rejected claims 57-64 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Allen* in view of U.S. Patent Application Pub. No. 2002/0029202 A1 ("*Lopez*") and in further view of *Anchor*.

By this Amendment, Applicants have amended claims 1, 4, 10-13, 16, 22-25, 28, 34-37, 58, 59, 61, 62, and 64. No new matter has been added. The amendments are supported at least by paragraphs 48-49 of Applicants' specification. Claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 remain pending and under current examination.

Regarding the Final Office Action's Response to Arguments

In the "Response to Arguments" section, the Final Office Action alleged that the chart on page 2 of *Anchor* shows storing the incorrect address having the delivery code error in the database. O.A. at 4. Applicants respectfully disagree. While the chart on page 2 of *Anchor* may disclose storing the old and new address from the national change of address database, *Anchor* fails to disclose or suggest that the uncorrected address (that contains the delivery code error) is stored in the database. Indeed, only the input file (mail file) of the chart shows the uncorrected address. Moreover, while the NCOA database may store old addresses, it does not store undeliverable addresses. The claims do not recite storing old addresses but rather the "incorrect address that

contains the delivery format error." The Final Office Action does not identify any specific text of *Allen* or *Anchor* disclosing or suggesting a database that stores an address having such a delivery format error. Both *Anchor* and *Allen* merely disclose storing former addresses, which do not contain delivery format errors.

Therefore, for at least the above reasons, the stored addresses of *Allen* and *Anchor* in the NCOA database do not constitute or suggest "storing a new instance of [a] resolved address comprising ... an incorrect address that contains a delivery format error," as recited in amended claim 1 (emphasis added).

Regarding Rejections of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established with respect to these claims.

To establish a *prima facie* case of obviousness, the Final Office Action must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. *See* M.P.E.P. § 2144.08(II)(A). Furthermore, the Final Office Action must make findings with respect to all of the claim limitations and must make "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *See Id.* §§ 2143.03 and 2141(III).

Claim 1 recites, among other things, the following elements:

> receiving a first item, the first item including a first instance of an incorrect address that contains a delivery format error;
>
> comparing the first instance of the incorrect address to a database of stored resolved addresses, the stored resolved

addresses comprising correct addresses and incorrect addresses having a delivery format error;

resolving the first instance of the incorrect address to determine a correct address in a predetermined delivery format by using at least one of a plurality of address resolution processes when it is determined that the first instance of the incorrect address fails to match one of the incorrect addresses of one of the stored resolved addresses; and

in response to resolving the first instance of the incorrect address, storing a new instance of a resolved address in the database, the new instance of the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error.

The Final Office Action conceded that *Allen* does not teach or suggest an "incorrect address that contains a delivery format error," and "storing a resolved address in a database," as recited in claim 1. O.A. at 5. However, the Final Office Action then alleged that *Allen* discloses "comparing the second instance of the incorrect address to the stored resolved address." O.A. at 5. *Allen* cannot fail to teach "storing a resolved address in a database" while at the same time teach "comparing the second instance of the incorrect address to the stored resolved address." For at least these reasons, *Allen* does not teach or suggest, among other things, "a first instance of an incorrect address that contains a delivery format error," "storing a new instance of a resolved address . . . comprising . . . the incorrect address that contains the delivery format error" and "comparing the second instance of the incorrect address to the stored first instance of the incorrect address associated with the resolved address," as recited in amended claim 58.

The Final Office Action alleged that *Anchor* teaches "receiving a first instance of an incorrect address that contains a delivery format error the incorrect address being associated with a first item." O.A. at 5. However, this is not correct. *Anchor* discloses identifying addressing errors and correcting them "before mail enters the mail stream." *Anchor* at p. 1 (emphasis added). A table on page 2 of *Anchor* shows that the incorrect address comes from a mail file, not an item, and *Anchor* explains that the system "processes your lists and makes all necessary address corrections." *Anchor* at p. 2 (emphasis added). Address lists and files are not mail items. For at least this reason, *Anchor* fails to disclose or suggest "receiving a first item, the first item including a first instance of an incorrect address that contains a delivery form error," as recited by amended claim 1.

The Final Office Action also alleged that *Anchor* teaches "storing a resolved address in a database; the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error." O.A. at 6. Applicants respectfully disagree. While *Anchor* may disclose a database of former addresses, *Anchor* fails to disclose "storing a new instance of a resolved address," as recited by claim 1. Furthermore, the former addresses in the NCOA database do not contain delivery format errors. The table on page 2 of *Anchor* shows that old addresses are stored in the database, rather than disclosing or suggesting that "a new instance of a resolved address . . . comprising . . . the first instance of the incorrect address that contains the delivery format error" is stored in the database. While *Anchor* may disclose that the mailing list of a customer may contain undeliverable addresses, this mailing list is not a database that stores "a new instance of a resolved address . . . comprising the

correct address and the first instance of the incorrect address," as recited in amended claim 1.

Moreover, neither *Anchor* nor *Allen* disclose or suggest "comparing the first instance of the incorrect address to a database of stored resolved address" or "resolving the first instance of the incorrect address to determine a correct address in a predetermined delivery format by using at least one of a plurality of address resolution processes when it is determined that the first instance of the incorrect address fails to match one of the incorrect addresses of one of the stored resolved addresses," as recited in amended claim 1.

For at least these reasons, even if *Anchor* is combined with *Allen*, as proposed by the Final Office Action, the combination still fails to disclose or suggest at least "receiving a first item, the first item including a first instance of an incorrect address that contains a delivery format error," "comparing the first instance of the incorrect address to a database of stored resolved address," "resolving the first instance of the incorrect address . . . using at least one of a plurality of address resolution processes when it is determined that the first instance of the incorrect address fails to match one of the incorrect addresses of one of the stored resolved addresses" and "in response to resolving the first instance of the incorrect address, storing a new instance of a resolved address in the database, the new instance of the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error," as recited in amended claim 1.

The Final Office Action cited *Lopez* as allegedly teaching processing of the first item for delivery in an item delivery system using the correct address and wherein the

first item comprises one of a letter and a package, and obtaining the first instance of the incorrect address from the surface of the first item. O.A. at 9. Even assuming the Final Office Action's characterization of *Lopez* is correct, which Applicants do not concede, *Lopez* fails to cure the deficiencies of *Anchor* and *Allen*, discussed above. That is, *Lopez*, also, fails to teach or suggest "receiving a first item, the first item including a first instance of an incorrect address that contains a delivery format error," "comparing the first instance of the incorrect address to a database of stored resolved address," "resolving the first instance of the incorrect address . . . using at least one of a plurality of address resolution processes when it is determined that the first instance of the incorrect address fails to match one of the incorrect addresses of one of the stored resolved addresses" and "in response to resolving the first instance of the incorrect address, storing a new instance of a resolved address in the database, the new instance of the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error," as recited in amended claim 1.

For at least the foregoing reasons, *Allen*, *Lopez*, and *Anchor*, whether taken alone or in combination, fail to teach or suggest the elements recited in claim 1, and the Final Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Final Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no

prima facie case of obviousness has been established for claim 1, and it is allowable over the cited references. Dependent claims 4-12 and 57-59 are also allowable, at least by virtue of their dependence from claim 1, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Although of different scope, independent claims 13, 25, and 37 include elements similar to those discussed above in connection with claim 1. For at least the same reasons discussed above with respect to claim 1, independent claims 13, 25, and 37 are allowable over the cited references. Dependent claims 16-24, 28-36, 40-48, and 60-64 are also allowable, at least by virtue of their dependence from one of independent claims 13, 25, or 37, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

The Final Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 15, 2011

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